

REMARKS

Claims 1-14 are pending in the application. Claims 1, 2, 4 – 8, 13 and 14 have been amended.

JP 64-41495 clearly discloses an expansion side damping force generating apparatus provided in the piston sliding within the cylinder and a compression side damping force generating apparatus provided in the sub-piston at the bottom of the cylinder. This device provides both expansion and compression damping.

The Examiner completely mischaracterizes this structure to the extent it is stated that one absorber provides compression and the other expansion damping. This concept appears nowhere in the description of the related art section, and nowhere in the reference itself.

The Examiner admits US Patent No. 5797594 (*Sekine*) teaches both expansion and compression damping in the same structure. It is not explained where the exclusive compression damping on the one side and expansion damping on the other side can be found in these references.

Regarding *Sekine*, the Examiner has mischaracterized this reference to the extent the Examiner states the device is arranged to only damp in one direction, such as compression. This device is merely a traditional dual action shock absorber.

It is proper to attack each reference first individually in this case to show that there is no structure in either cited reference which could be combined to result in the claimed invention. The constituent elements are entirely missing, and the combination cannot therefore include the claimed elements.

The cited devices would need to be completely redesigned to eliminate one or the other of the compression/expansion valving structures in order to arrive at the presently claimed invention. There is no motivation in either reference to do so.

On page 3, lines 15-18 of the May 20, 2005 Official Action, the Examiner states: "...and two oil passages 20, 21 provided in the piston, a compression side damping valve 23 being provided in one oil passage, and a check valve 22 closing during compression and opening during expansion being provided in the other oil passage." Applicant respectfully asserts that this characterization is wrong and that the Examiner mistook "a disk valve 22" of *Sekine* to be "a check valve." This "disk valve 22" is not a check valve, but a damping force generating valve that opens with a prescribed pressure. See, *Sekine* at Col. 4, lines 38 to 50. Specifically in *Sekine*, there are provided an expansion side disk valve 22 and a

compression side disk valve 23 respectively on the both side of one piston 15, and one damper generates both damping forces on the expansion side and the compression side. The cited reference of *Sekine* does not disclose any of the check valve of Claims 1, 2, 13, and 14 of the present invention.

Further, with respect to "a volume compensating oil passage" of Claims 1, 2, 13, and 14 of the present invention, the Examiner recognizes "19a" of *Sekine* as a volume compensating oil passage citing Col. 3, lines 5<sup>th</sup> to 3<sup>rd</sup> from the bottom and Col. 4, 2<sup>nd</sup> line from the bottom to Col. 5, line 2. However, "19a" of *Sekine* is not a volume compensating oil passage. A volume compensating oil passage should make the oil flow free between the piston rod side oil chamber and the oil reservoir chamber at the time of the compression and also the extension of the front fork. On the other hand, in *Sekine*, the passage 19a communicates a piston rod side oil chamber with an oil reservoir chamber via a check valve 19b. According to this construction, the check valve 19b interrupts the oil flow which is necessary for the volume compensating at the time of compression, from the oil reservoir chamber to the piston rod side oil chamber. Thus, the passage 19a can not be a volume compensating oil passage. See, for example, Col. 4, lines 27 to 37 of *Sekine*. Accordingly, *Sekine* does not disclose any of the volume compensating oil passage of Claims 1, 2, 13, and 14 of the present invention.

The current claim amendments even more clearly set out the distinctions with respect to the cited art.

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**CONCLUSION**

Having obviated the Examiner's objections, applicant seeks an early indication of allowance.

Respectfully submitted,

  
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